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Pillsbury Winthrop Shaw Pittman LLP  
In conjunction with the  
State Bar of California's Intellectual Property Law Section's  
Copyright Committee present

***"DOIN' IT IN THE STREETS":***

***Film & TV Rights & Clearances From Second Unit Scout to the Director's Cut***

Presented by  
Jessica L. Darraby  
Darraby Law

*The Art of Counsel—Counsel to the Arts™*

Onsite location filming is a billion dollar business in California. California is a unique state for urban eye-candy for film and television, with diverse scenery, architecture, public art, and visual infrastructure ranging from mountains and forests to deserts and seas. What rights and clearances do production companies and studios need before copyrighted architecture is splashed across the silver screen? How to determine when street lights, park gates, benches, and building facades are merely design engineering or public art? Who owns the copyrights? How to get the licenses for use in the street shots and valuable after-market merchandising? How to clear the rights to build the maquettes and 3D models of the urban street scene for special effects set-ups when the proprietary owners have registered the rights?

Tuesday, May 6, 2008  
12:00 Noon

Hosted By:  
Pillsbury Winthrop Shaw Pittman LLP  
50 Fremont Street  
Room 624-28  
San Francisco, CA 94105

Reservation Form Attached  
\$20 (In-Person Attendees)  
Lunch Included

Conference Call Attendees: Free  
Call-In Number: 1-866-844-4956 (Password: 9555037)

*1 Hour MCLE credit for in-person attendees will be provided by Pillsbury Winthrop Shaw Pittman LLP*

**Art,  
Artifact &  
Architecture  
Law**

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**2006 Edition  
Jessica L. Darraby**

## **APPENDIX 18E**

### **Copyright—Exclusive Rights Architectural Works: 17 U.S.C.A. § 120**

#### **§ 120. Scope of exclusive rights in architectural works**

**(a) Pictorial representations permitted.**--The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

**(b) Alterations to and destruction of buildings.**--Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building.

## **APPENDIX 18F**

### **Architectural Works**

#### **37 CFR § 202.11**

##### **§ 202.11. Architectural works**

(a) General. This section prescribes rules pertaining to the registration of architectural works, as provided for in the amendment of title 17 of the United States Code by the Architectural Works Copyright Protection Act, title VII of the Judicial Improvements Act of 1990, Public Law 101-650.

##### **(b) Definitions**

(1) For the purposes of this section, the term architectural work has the same meaning as set forth in section 101 of title 17, as amended.

(2) The term building means humanly habitable structures that are intended to be both permanent and stationary, such as houses and office buildings, and other permanent and stationary structures designed for human occupancy, including but not limited to churches, museums, gazebos, and garden pavilions.

##### **(c) Registration—**

(1) Original design. In general, an original design of a building embodied in any tangible medium of expression, including a building, architectural plans, or drawings, may be registered as an architectural work.

(2) Registration limited to single architectural work. For published and unpublished architectural works, a single application may cover only a single architectural work. A group of architectural works may not be registered on a single application form. For works such as tract housing, a single work is one house model, with all accompanying floor plan options, elevations, and styles that are applicable to that particular model.

(3) Application form. Registration should be sought on Form VA. Line one of the form should give the title of the building. The date of construction of the building, if any, should also be designated. If the building has not yet been constructed, the notation "not yet constructed" should be given following the title.

(4) Separate registration for plans. Where dual copyright claims exist in technical drawings and the architectural work depicted in the drawings, any claims with respect to the technical drawings and architectural work must be registered separately.

(5) Publication. Publication of an architectural work occurs when underlying plans or drawings of the building or other copies of the building design are distributed or made available to the general public by sale or other transfer of ownership, or by rental, lease, or lending. Construction of a building does not itself constitute publication for purposes of registration, unless multiple copies are constructed.

(d) Works excluded. The following structures, features, or works cannot be registered:

(1) Structures other than buildings. Structures other than buildings, such as bridges, cloverleaves, dams, walkways, tents, recreational vehicles, mobile homes, and boats.

(2) Standard features. Standard configurations of spaces, and individual standard features, such as windows, doors, and other staple building components.

(3) Pre-December 1, 1990 building designs.

(i) Published building designs. The designs of buildings where the plans or drawings of the building were published before December 1, 1990, or the buildings were constructed or otherwise published before December 1, 1990.

(ii) Unpublished building designs. The designs of buildings that were unconstructed and embodied in unpublished plans or drawings on December 1, 1990, and remained unconstructed on December 31, 2002.

[57 FR 45310, Oct. 1, 1992; 68 FR 38630, June 30, 2003]

## **APPENDIX 18G-1**

### **Visual Arts Registry 37 CFR § 201.25**

#### **§ 201.25. Visual Arts Registry.**

(a) General. This section prescribes the procedures relating to the submission of Visual Arts Registry Statements by visual artists and owners of buildings, or their duly authorized representatives, for recordation in the Copyright Office under section 113(d)(3) of title 17 of the United States Code, as amended by Public Law 101-650, effective June 1, 1991. Statements recorded in the Copyright Office under this regulation will establish a public record of information relevant to an artist's integrity right to prevent destruction or injury to works of visual art incorporated in or made part of a building.

(b) Forms. The Copyright Office does not provide forms for the use of persons recording statements regarding works of visual art that have been incorporated in or made part of a building.

#### **(c) Recordable statements—**

(1) General. Any statement designated as a "Visual Arts Regulatory Statement" and which pertains to a work of visual art that has been incorporated in or made part of a building may be recorded in the Copyright Office provided the statement is accompanied by the fee for recordation of documents specified in section 708(a)(4) of title 17 of the United States Code. Upon their submission, the statements and an accompanying documentation or photographs become the property of the United States Government and will not be returned. Photocopies are acceptable if they are clear and legible. Information contained in the Visual Arts Registry Statement should be as complete as possible since the information may affect the enforceability of valuable rights under the copyright law. Visual Arts Registry Statements which are illegible or fall outside of the scope of section 113(d)(3) of title 17 may be refused recordation by the Copyright Office.

(2) Statements by artists. Statements by artists regarding a work of visual art incorporated or made part of a building should be filed in a document containing the head: "Registry of Visual Art Incorporated in a Building—Artist's Statement." The statement should contain the following information:

(i) Identification of the artist, including name, current address, age, and telephone number, if publicly listed.

(ii) Identification of the work or works, including the title, dimensions, and physical description of the work and the copyright registration number, if known. Additionally, it is recommended that one or more 8 x 10 photographs of the work on good quality photographic paper be included in the submission; the images should be clear and in focus.

(iii) Identification of the building, including its name and address. This identification may additionally include 8 x 10 photographs of the building and the location of the artist's work in the building.

(iv) Identification of the owner of the building, if known.

(3) Statements by the owner of the building. Statements of owners of a building which incorporates a work of visual art should be filed in a document containing the heading: "Registry of Visual Art Incorporated in a Building—Building Owner's Statement." The statement should contain the following information:

(i) Identification of the ownership of the building, the name of a person who represents the owner, and a telephone number, if publicly listed.

(ii) Identification of the building, including the building's name and address. This identification may additionally include 8 x 10 photographs of the building and of the works of visual art which are incorporated in the building.

(iii) Identification of the work or works of visual art incorporated in the building, including the works' title(s), if known, and the dimensions and physical description of the work(s). This identification may include one or more 8 x 10 photographs of the work(s) on high quality photographic paper; the images should be clear and in focus.

(iv) Identification of the artist(s) who have works incorporated in the building, including the current address of each artist, if known.

(v) Photocopy of contracts, if any, between the artist and owners of the building regarding the rights of attribution and integrity.

(vi) Statement as to the measures taken by the owner to notify the artist(s) of the removal or pending removal of the work of visual art, and photocopies of any accompanying documents.

(4) Updating statements. Either the artist or owner of the building or both may record statements updating previously recorded information by submitting an updated statement and paying the recording fee specified in paragraph (d) of this section. Such statements should repeat the information disclosed in the previous filing as regarding the name of the artist(s), the name of the work(s) of visual art, the name and address of the building, and the name of the owner(s) of the building. The remaining portion of the statement should correct or supplement the information disclosed in the previously recorded statement.

(d) Fee. The fee for recording a Visual Arts Registry Statement, a Building Owner's Statement, or an updating statement is the recordation fee for a document, as prescribed in § 201.3(c).

(e) Date of recordation. The date of recordation is the date when all of the elements required for recordation, including the prescribed fee have been received in the Copyright Office. After recordation of the statement, the sender will receive a certificate of record from the Copyright Office. Any documentation or photographs accompanying any submission will be retained and filed by the Copyright Office. They may also be transferred to the Library of Congress, or destroyed after preparing suitable copies, in accordance with usual procedures.

(f) Effect of recordation. The Copyright Office will record statements in the Visual Arts Registry without examination or verification of the accuracy or completeness of the statement, if the statement is designated as a "Visual Arts Registry Statement" and pertains to a work of visual art incorporated in or made part of a building. Recordation of the statement and payment of the recording fee shall establish only the fact of recordation in the official record. Acceptance for recordation shall not be considered a determination that the statement is accurate, complete, and otherwise in compliance with section 113(d), title 17, U.S. Code.

The accuracy and completeness of the statement is the responsibility of the artist or building owner who submits it for recordation. Artists and building owners are encouraged to submit accurate and complete statements. Omission of any information, however, shall not itself invalidate the recordation, unless a court of competent jurisdiction finds the statement is materially deficient and fails to meet the minimum requirements of section 113(d), title 17, U.S. Code.

SOURCE: [56 FR 38341, Aug. 13, 1991]

AUTHORITY: Sec. 702, 90 Stat. 2541, 17 U.S.C.A. 702; 201.7 is also issued under 17 U.S.C.A. 408, 409, and 410; 201.16 is also issued under 17 U.S.C.A. 116; 201.17 is also issued under 17 U.S.C.A. 111.



## APPENDIX 18G-2

### Visual Arts Registry Certification

Copyright  
Office  
of the  
United  
States

THE  
LIBRARY  
OF  
CONGRESS

THIS IS TO CERTIFY THAT IN ACCORDANCE  
WITH SECTION 201.25 OF TITLE 37, U. S. CODE,  
A VISUAL ARTS REGISTRY STATEMENT  
HAS BEEN FILED IN THE COPYRIGHT OFFICE.

Date of Filing:

☐ Artist's Statement

☐ Building Owner's Statement

Name and Address of the Building:

Title(s), and/or Description of the Art Work(s):

Name and Address of Artist(s):

Name and Address of Owner of Building:

IN WITNESS WHEREOF, THE SEAL OF THIS  
OFFICE IS AFFIXED HERETO ON



Register of  
Copyrights and  
Associate  
Librarian for  
Copyright  
Services

Visual Arts Registry  
C-807 August 1994-25

**B. DAMAGES**

- § 7:130 Section 504
- § 7:131 Actual damages
- § 7:132 Profits
- § 7:133 Statutory damages

**C. ATTORNEY'S FEES AND COSTS**

- § 7:134 Attorney's fees
- § 7:135 Costs
- § 7:136 Criminal infringement

**XI. INSURANCE**

- § 7:137 Generally

**KeyCite®:** Cases and other legal materials listed in KeyCite Scope can be researched through the KeyCite service on Westlaw®. Use KeyCite to check citations for form, parallel references, prior and later history, and comprehensive citator information, including citations to other decisions and secondary materials.

**I. GENERALLY****§ 7:1 Introduction**

Copyright is codified in Title 17 of the U.S. Code. Copyright arises from the fixation of images in specified forms. The legal requirements are relatively straightforward: Copyright provides a limited monopoly for limited duration<sup>1</sup> to the creator, its assigns, or survivors for works of original authorship fixed in a tangible medium of expression. The copyright owner has the power to exploit individually or collectively an exclusive bundle of divisible rights during the limited time period. Subject matter of copyright includes pictorial, graphic, and sculptural works (PGS).

Section 102 of the U.S. Code<sup>2</sup> provides that "copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed," which includes "pictorial, graphic and sculptural works,"<sup>3</sup> and "architectural works."<sup>4</sup> Note that the Section 102 subject matter of copyright does not now include, and never included, the term "visual art."

To succeed in a copyright action, the plaintiff must prove ownership of a valid copyright and infringement of the copyright by unauthorized use. Injunctive relief, actual damages, and, in some instances, statutory damages, attorneys' fees, and

**[Section 7:1]**

<sup>1</sup>1989 H.R. Rep. No. 2589, 105th Cong., 2d Sess. (1988) (The Sonny Bono Copyright Term Extension Act (CTEA), approved by Congress in 1998, extends copyright from life plus fifty to seventy years for general works and joint works created since 1978, and extends time periods for works made-for-hire and other works, in addition to making substantive changes in duration of copyright for subsisting copyrights). The constitutionality of CTEA has been upheld. *Eldred v. Ashcroft*, 537 U.S. 186, 123 S. Ct. 769, 154 L. Ed. 2d 683, 65 U.S.P.Q.2d (BNA) 1225 (2003) (Bryer, J. and Stevens, J., dissenting).

<sup>2</sup>17 U.S.C.A. § 102; see also 17 U.S.C.A. § 101, definition revised by Act of Oct. 31, 1988, Pub L. No. 100-568.

<sup>3</sup>17 U.S.C.A. § 102(5).

<sup>4</sup>17 U.S.C.A. § 102(8).

costs are available.

The copyright concept of limited monopoly to regulate use of visual imagery is alien to artmaking, which has evolved over thousands of years based upon the principle and practice of copying—quotation, imitation and appropriation. Unauthorized copying, for which no fees are paid or licenses obtained, is the basis of art apprenticeship, art technique, and art education. “Copied” art is stock-in-trade in the art markets. After thousands of years of artmaking, only the last decade has produced case law that has the profound potential of imposing new costs upon artists for that revered pedagogical, tutorial, and historical methodology integral to the evolution of art: copying.

The societal goal underlying copyright is to stimulate and encourage progress in the arts.<sup>5</sup> Copyright supposedly sparks creative impulse through economic impetus. Conversely, unauthorized copying inhibits creativity. No empirical study supports this assertion for visual art, and history suggests the contrary; the compulsion to create without remuneration survives even when impecunious circumstances dictate otherwise. The greatest gifts of artistic genius have come down to us through the millennia without copyright motivation. Master artworks from ages past might not have been created if copyright costs had been imposed for visual arts. Aside from the artists themselves, copyright imposes a cost upon their patrons, private and institutional collectors.

Copyright is a structure for economically rewarding activity (not necessarily creativity) in commerce. Claims that copyright is impetus and reward for creative exploitation are simply not borne out upon review of art cases. Culture does not easily track economic models nor is it clear that copyright policy should apply to cultural commerce. Nonetheless, Congress and the courts have chosen to bring art under the copyright umbrella, or at least some of it. The cases compel the lawyer to differentiate fine art—which in this chapter only refers to object oriented, one-of-a-kind works, and editions of extremely limited number, from commercial art—works whose primary value is not intrinsic to the object, but is dependent upon reproductive values through usage, whether it is derivation, reproduction, and/or display, including expanded meanings of these terms to encompass internet use. That scrutiny must be paid to differentiate art for purposes of copyright is ironic for several reasons: distinctions between fine and commercial art are, and have been, blurring; technology conflates product and process, undermining formal categorizations as it creates new categories; the jurisprudence that brought art within the copyright umbrella purported to eschew just such line drawing.

Copyright has historically been incongruous with art history, where copying is a mainstay, but novelty is a hallmark. Technology, advances in digitalization and the internet, innovative multisite installations, and encoded Net art are changing basic concepts and beliefs in the visual arts, and challenging the attendant policies of copyright. Whether artists making one-of-a-kind artworks will use copyright to stop cultural progeny from copying their art is unclear, but not one such case could be found.

<sup>5</sup>Eldred v. Ashcroft, 123 S. Ct. 769, 154 L. Ed. 2d 683, 65 U.S.P.Q. 2d (BNA) 1225 (U.S. 2003) (Bryer, J. and Stevens, J., dissenting) (“[t]he economic philosophy behind the [Copyright] Clause . . . is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors . . . [the] law ‘celebrates the profit motive, recognizing that the incentive to profit from the exploitation of copyrights will redound to the public benefit by resulting in the proliferation of knowledge. . . . [R]ewarding authors for their creative labor and ‘promoting . . . Progress’ are thus complementary.”)

The cases overwhelmingly demonstrate that copyright can provide legal relief for commercial artists, graphic artists, and photographers, who typically receive little or no remuneration for the tangible work produced, and rely for livelihood upon licensing fees for copying, reproduction, and display of artworks. Even when relief is granted, damages awards may not compensate a plaintiff unless damages are fairly interpreted to adjust financial inequities between commercial artists and high end arts infringers. The internet impacts not only basic tenets of copyright but the relief awarded to those infringed.<sup>6</sup>

This chapter does not recite the law of copyright nor is it intended to do so; comprehensive treatises and hornbooks devoted exclusively to copyright are readily available. Familiarity with the law of copyright is assumed. What follows in §§ 7:2 to 7:11, a subset of art copyright; §§ 7:12 to 7:19, a summary evolution of art within copyright law; §§ 7:20 to 7:43, a practice and procedure guide for registering art and providing notice on artworks; §§ 7:44 to 7:70, an analysis of how copyright issues have been applied to the arts; §§ 7:71 to 7:86, a case analysis presented by copyright issues; §§ 7:87 to 7:102, the fair use defense as applied to art and its relationship to the first amendment; §§ 7:102 to 7:112, specific types of art, like cartoons and comic strips, photography; §§ 7:114 to 7:127, laws and cases involving architectural copyright, including buildings and plans from before and after enactment of AWCPA; §§ 7:128 to 7:136, remedies available, civil and criminal offenses including actual damages, statutory damages, and injunctive relief, and attorney's fees and costs; and § 7:137, insurance.

Many of the applicable statutory sections and regulations for the Revised Copyright Act of 1976 and subsequent amendments are quoted for the reader's convenience. Where relevant, prior versions of copyright law, e.g., the Act of 1909, and legislative history are quoted or identified.

Title 17 of the U.S. Code is the repository of copyright law, and Congress chose to include there two Berne Convention rights some European countries provide to visual artists: (1) the right of attribution and (2) the right of integrity. Those rights do not bestow copyright to visual art; they do not expand copyright protection to visual art; they are not "subject matter" of copyright; they are not subject to most copyright procedures and requirements; and they are unrelated to the prevailing policies underlying copyright. These rights are mentioned in §§ 7:2 to 7:11 in the context of art copyright evolution, and are fully addressed as artist's rights.<sup>7</sup>

## II. HISTORY OF VISUAL ART AND COPYRIGHT LAW

### A. CONSTITUTIONAL BASIS

#### § 7:2 Generally

Article I, section 8, clause 8 of the U.S. Constitution is the constitutional predicate for federal copyright and patent law.<sup>1</sup> Congress has the power "[t]o promote the . . . useful Arts by securing for limited Times to Authors and Inventors the exclusive

<sup>6</sup>See, e.g., *In re Napster, Inc. Copyright Litigation*, 191 F. Supp. 2d 1087 (N.D. Cal. 2002).

<sup>7</sup>See Ch 9.

#### [Section 7:2]

<sup>1</sup>Patent law is not discussed in this chapter. For patents, see 35 U.S.C.A. §§ 101 et seq. Patent does not preclude copyright of art work attached to, part of, or on the patented work; see, e.g., *Application of Yardley*, 493 F.2d 1389 (C.C.P.A. 1974) (artwork on the face of Spiro Agnew watch was copyrightable even though watch was patentable); accord, *Mazer v. Stein*, 347 U.S. 201, 74 S. Ct. 460,

Right to their respective Writings and Discoveries.”<sup>2</sup> Visual art was certainly not within the scope of the drafters’ imaginations or intentions; *The Federalist Papers* are silent on this issue.<sup>3</sup> The pre-Revolutionary English Statute of Anne,<sup>4</sup> the cornerstone from which American copyright originates, did not encompass visual art: “An Act for the encouraging of learning, by vesting of the copies of printed books in the authors or purchasers of such copies, during the times . . . mentioned.”<sup>5</sup> Nor did visual art appear in letter or spirit in the first copyright law of 1790; 200 years elapsed before the Visual Artists Rights Act of 1990 codified the term “visual art” in federal copyright.<sup>6</sup> The following sections summarize what occurred during these two centuries to bring the law to its current, and continuously evolving, state.

## B. JUDICIAL EXPANSION

### § 7:3 Originality, authorship, novelty

Copyright protection exists in original works of authorship fixed in any tangible medium of expression codified in title 17 of the U.S. Code.<sup>1</sup> “Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed,” which includes “pictorial, graphic and sculptural works” (PGS)<sup>2</sup> and “architectural works.”<sup>3</sup> Those two categories, PGS and architectural works, contain most of the subject matter of this work.<sup>4</sup> Artworks were presumably not within the contemplation of the drafters of the Constitution or the members of the First Congress.<sup>5</sup>

The expansive view of copyright to umbrella the arts evolved over many, many years, and continues to this day. Initially, the courts grappled with what constituted originality<sup>6</sup> and authorship to satisfy the Constitution.

Originality is a legal term of art under copyright that is not coterminous with artistic originality recognized in the arts. The requirement of originality is judicially imposed based upon interpretation of copyright protection for “authors;” authors, for

98 L. Ed. 630 (1954) (sculptural base of table lamps that were patentable did not prevent copyright protection as works of art).

<sup>2</sup>U.S. Constitution, Art. I, § 8, cl. 8 (“The Congress shall have Power . . . To Promote the . . . useful Arts . . . (for purposes of copyright protection)”).

<sup>3</sup>The Federalist Papers No. 43 (Madison).

<sup>4</sup>Act of Anne 8, Ch. 19, (1710) (authors and their heirs had sole right to print or copy work for fourteen years).

<sup>5</sup>Act of Anne 8, ch. 19, (1710); see *Eldred v. Ashcroft*, 123 S. Ct. 769, 154 L. Ed. 2d 683 (U.S. 2003) (history of Statute of Anne); *but cf.* *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 4 S. Ct. 279, 28 L. Ed. 349 (1884) (mention of early king’s bench and queen’s bench cases cited for proposition that courts applied copyright to intellectual products).

<sup>6</sup>Pub. L. No. 101-650, 104 Stat. 3048 (1990).

#### [Section 7:3]

<sup>1</sup>All sections refer to title 17 of the U.S. Code, the revised 1976 Copyright Act, and subsequent amendments, unless otherwise specified.

<sup>2</sup>17 U.S.C.A. § 102(a)(5).

<sup>3</sup>17 U.S.C.A. § 102(a)(8).

<sup>4</sup>See §§ 7:103 to 7:113.

<sup>5</sup>See § 7:2. Benjamin Franklin, who dabbled in watercolors, was an art aficionado, and other authors had common knowledge of painting and sculpture; see also, *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 4 S. Ct. 279, 28 L. Ed. 349 (1884) (framers did not include photography in 1780s because it did not exist at the time).

<sup>6</sup>See §§ 7:44 to 7:53 (discussion of requirements of “original works of authorship”).

purposes of clause 8, are originators. Originality is considered a constitutional imprimatur "read into the Copyright Act" so that the requirement of originality is both constitutional and statutory.

<sup>7</sup> Determining originality is a matter of law.<sup>7</sup> Ch 1 emphasized the difficulty of generally defining "originality" in an arts context. *Baker v. Selden*<sup>8</sup> in the 19th century made clear the Court's position that originality does not require something novel or new. More than 100 years later, the Court is still grappling with definitions: Originality is satisfied if there is "independent creation and a modicum of creativity."<sup>9</sup>

The threshold for originality is generally considered so low it has been held to be "little more than a prohibition of actual copying."<sup>10</sup> Although novelty, inventiveness, and aesthetic merit<sup>11</sup> are not required in the sense of striking uniqueness or ingeniousness, "the 'author' [must] contribute [ ] something more than a 'merely trivial' variation, something recognizably 'his own.'"<sup>12</sup> "The requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be."<sup>13</sup>

In *Bleistein*,<sup>14</sup> where circus posters were protected, the Court found originality could be supported in imagery, whether taken from life, natural realism, or by pure invention. Life drawing, model portraiture, and pure fantasy were equally protectible. There, lithography company employees created advertising posters based upon descriptions of circus acts made by the shop's customer—the circus owner—the Court asserted that life drawing and live performance were also protected: "a portrait by Velasquez or Whistler [is not] common property because others . . . try their hand on the same face. Others are free to copy the original. They are not free to copy the copy [created by the author]. There is no reason to doubt that these prints in their *ensemble* and in all their details . . . are . . .

<sup>7</sup> *Hearn v. Meyer*, 664 F. Supp. 832, 839 (S.D. N.Y. 1987).

<sup>8</sup> *Baker v. Selden*, 101 U.S. 99, 102–03, 25 L. Ed. 841 (1879).

<sup>9</sup> *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 111 S. Ct. 1282, 1287–88, 113 L. Ed. 2d 358 (1991); see also *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 41 Fed. R. Serv. 3d 1368 (2d Cir. 1998) (although independent creation can create copyright even if work is identical to preexisting work, song lyrics "You've Got to Stand For Something/Or You'll Fall For Anything" lacked requisite originality where defendant's evidence showed widespread public usage).

<sup>10</sup> *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951).

<sup>11</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S. Ct. 298, 47 L. Ed. 460 (1903) (circus posters copyrightable as works "connected with the fine arts" under statute no longer in force).

<sup>12</sup> *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976), quoting *Alfred Bell & Co. v. Catalda Fine Arts*, 74 F. Supp. 973 (S.D. N.Y. 1947), decision supplemented, 75 U.S.P.Q. (BNA) 283, 1947 WL 3391 (S.D. N.Y. 1947), decision supplemented, 86 F. Supp. 399 (S.D. N.Y. 1949), judgment modified, 191 F.2d 99 (2d Cir. 1951); *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191 (S.D. N.Y. 1999) ("slavish" copying insufficient to support originality); *E. Mishan & Sons, Inc. v. Marycana, Inc.*, 662 F. Supp. 1339, 1342 (S.D. N.Y. 1987) (although Americana-style calico and lace kitchen magnets did not have high degree of novelty and plaintiff failed to show magnets lacked "independent authorship").

<sup>13</sup> *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991).

<sup>14</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S. Ct. 298, 47 L. Ed. 460 (1903).

original.”<sup>15</sup>

The Supreme Court has recently reaffirmed originality’s minimal threshold.<sup>16</sup> Thus the use of a petroglyph as the middle two zeros in a “2000” calendar had the “requisite originality.”<sup>17</sup>

“Authorship,” a key copyright term, has been expanded incrementally by judicial interpretation. In *Burrow-Giles*,<sup>18</sup> where a particular portrait photograph of Oscar Wilde copied by a lithography company was proffered by the artist as protectible material, the Supreme Court emphasized that authorship simply means the copyrighted work originates with that person: “An author . . . is an . . . originator . . . maker . . . By writings . . . is meant the literary productions of those authors . . . and Congress . . . properly . . . declared these to include all forms of writing, printing, engraving, etching etc., by the ideas in the mind of the author are given visible expression.”

**Chart 7-1: Origination of Artwork Copyrights Under Federal Law Prior to 20th Century**

Year	Law	Protectible Works
1789	U.S. Constitution, Art. 1, § 8, cl. 8	useful arts, writings
1790	1 Stat. 124 (First Congress)	authors of maps, charts, books; fourteen-year protection from publication, renewable for 14 years
1802	2 Stat. 171	fourteen-year protection extended to inventors and designers who engrave, etch or work historical or other prints
1831	4 Stat. 436 *	twenty-eight-year protection added for prints and engravings (and all above) from publication, renewable for 14 years
1865	13 Stat. 540	“photographs and the negatives thereof”
1874	R.S. Stat. 4952	prints, paintings, drawings, cuts, chromo engravings, photographs, statues, statuary, and models or designs (intended to be perfected as works of the fine arts)

<sup>15</sup>*Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S. Ct. 298, 47 L. Ed. 460 (1903) (emphasis in original).

<sup>16</sup>*Eldred v. Ashcroft*, 123 S. Ct. 769, 154 L. Ed. 2d 683 (U.S. 2003), citing *Feist Publ., Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345, 359 (1991) (“[T]he *sine qua non* of copyright is originality . . . [but] [o]nly “a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent” will not be original.”).

<sup>17</sup>*Willard v. Estern*, 206 F. Supp. 2d 723 (D.V.I. 2002) (summary judgment denied because combined petroglyph and calendar date reflected artist’s decision and creation).

<sup>18</sup>*Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57–58, 4 S. Ct. 279, 28 L. Ed. 349 (1884) (holding constitutional R.S. Stat 1874 making “photographs and the negatives thereof” copyrightable).

Year	Law	Protectible Works
1874	18 Stat. 78-79	"fine arts" restriction for prints, cuts, and engravings
1884	<i>Burrow-Giles</i> **	Sup. Ct. applies R.S. Stat. 4952 to photographs
1909	35 Stat. 1080-1081	28 years from publication, renewable 28 years
1976	Pub. L 94-553	Pictorial, Graphic, Sculptural (PGS) works: life plus fifty years from creation for persons; anonymous, pseudonymous and work for hire, 75 years from publication or 100 years from creation, whichever expires first
1990	AWCPA Pub. L 101-650	plans, designs, drawings, buildings
1998	CTEA *** Pub.L. 105-298 § 102(b) and (d)	life plus seventy from creation for persons; anonymous, pseudonymous and work for hire, 95 years from publication or 120 years from creation, whichever expires first

\* First use of term "copyright" in federal legislation (repeals Acts of 1790 and 1802).

\*\* *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) ("The Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.").

\*\*\* *Eldred v. Ashcroft*, 123 S. Ct. 769, 154 L. Ed. 2d 683 (U.S. 2003) (CTEA constitutionality upheld).

After *Burrow-Giles*, authors were no longer limited to creators of "writings," visual artists, designers, engravers, photographers, lithographers, and others who did not make "writings" could now qualify as "authors."

The foregoing seemingly simple oft-quoted propositions establish the scope and tone of copyright that persists to the present day. These rules have become veritable adages. In each case the artwork at issue should be evaluated within the particular facts and circumstances, enabling practitioners to draw successfully from general copyright principles to the specifics of the case or matter.

#### § 7:4 "Useful" art, fine art

The Constitution expressly modifies "arts" by the adjective "useful." The fine arts are not useful; indeed, a common definition of fine art is work created to fulfill no utilitarian purpose. That has not presented a constitutional hurdle because the requirement of usefulness was disposed of early on in *Bleistein v. Donaldson Lithographing Co.*<sup>1</sup> There, the Court had to determine whether advertising posters were useful arts or were related to the fine arts. The posture of that case, which required the Supreme Court to accomplish two different (and incompatible) goals, should be thoroughly understood because it dramatically affects art copyright to the

#### [Section 7:4]

<sup>1</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S. Ct. 298, 47 L. Ed. 460 (1903).



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Leicester v. Warner Bros.  
C.D.Cal., 1998.

United States District Court, C.D. California.  
Andrew LEICESTER, Plaintiff,

v.

WARNER BROS., et al., Defendants.  
No. CV95-4058-HLH(CTX).

May 29, 1998.

# MEMORANDUM OPINION AND FINDINGS OF FACT IN RE PHASE I TRIAL

HUPP, District J.

\*1 Phase I of this bifurcated case was tried to the court on August 27 and 28, 1996, Gregory B. Wood, Esq., appearing for the plaintiff, and Robert M. Schwartz, Esq. and Alan Rader, Esq., appearing for defendants.

The Phase I issues, tried non-jury, consisted of:

1. Interpretation of the contract between plaintiff and R & T Development Corporation (hereafter "R & T").
2. Determination of who is the creator of the Zanja Madre, or its pertinent parts, and
3. Whether the alleged infringement involved an "architectural work" under 17 USC § 102(a)(8), together with the exception to protection provided in 17 USC § 120(a). (All references hereafter to the Copyright Act are deemed to the appropriate sections in Title 17.)

The court determined the issues as set forth below. This document will serve as Findings of Fact and Conclusions of Law unless either party desires additional Findings of Fact and Conclusions of Law, which, if desired, should be promptly requested.

a. *Factual Background:* R & T, purchaser of certain

real property from the Los Angeles Community Re-development Agency (hereafter CRA) desired to construct a 24-story office building in CRA territory at the southwest corner of 8th and Figueroa Streets in Los Angeles. To do so, R & T was required to comply with CRA policies requiring a "percent for art" expenditure, or a payment to CRA of a minimum amount for the construction of public art in connection with the development. R & T chose to provide its own artistic development in connection with the building. The building as planned and constructed is shown in exhibit 198, FN1 a view taken from diagonally across the intersection of 8th and Figueroa. The artistic development, subsequently known as Zanja Madre (hereafter referred to as ZM) was primarily to be located on the southerly side of the picture (the left side of exhibit 198). R & T hired an architect, TAC, whose principal John Hayes was the main architect for the project. Thereafter, R & T employed the plaintiff, Andrew Leicester, as the artist to develop and carry out the artistic development required by CRA. Mr. Leicester worked within the physical parameters available, basically a courtyard space on the south side of the building. His artistic development needed not only to satisfy the owners of the property, R & T, but also be approved by the CRA, which had separate committees to review both the architectural and the artistic components of the project. Mr. Leicester developed three plans for the artistic elements. The first was rejected by CRA. The second was rejected by the owner. The third resulted in the construction of ZM as it now exists. This artistic development is illustrated in exhibits 1100, 1094, 266, and 196. The artistic development included separate artistic works intended by Mr. Leicester to tell an allegorical story involving certain elements of the history of Los Angeles. In the courtyard proper, there was a fountain consisting of rock split by an arrowhead from which water issued (exhibit 196). The water flowed down a channel intended to represent the "Zanja Madre" (literally the "mother ditch"), the main water ditch bringing wa-

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ter to Los Angeles in its early history (exhibits 1184, 1094 and 1100). Inside the perimeter of the courtyard, there were two sets of two towers, one set illustrating a replica of a city building and another set with what appears to be a drill bit on the top of each tower representing the need for water (exhibit 1094). The courtyard also has benches and gardens for the use of the public (see exhibit 1100). The Figueroa Street perimeter of the courtyard, extending southerly from the edge of the building, consists of five towers. Two of these towers (called herein the lantern towers) have lanterns topped by a grillwork assembly, and two of the towers (called herein smoke towers), are topped by a metalwork design illustrating smoke flattening out under an inversion layer in Los Angeles. There is one more shorter tower from which the main gates are attached which is topped by a vampire figure.<sup>FN2</sup>(See exhibit 194.)

FN1. The photographs attached here are black and white Xerox copies of the color photos in evidence. The originals are much clearer.

FN2. Mr. Leicester's representation is, as aforesaid, fanciful, and is thus not to be taken as showing literally items from the history of Los Angeles. For example, no water from the Lake Arrowhead region of the San Bernardino Mountains was ever transported to Los Angeles in a zanja or otherwise. The original zanja was an irrigation ditch established by the early settlers which extended from somewhere near the intersection of north Broadway and the Los Angeles River down to the farmland now covered by downtown Los Angeles. That irrigation ditch provided irrigation water, not water for the city. Nevertheless, Mr. Leicester's project carries out the theme of illustrating the dependence of the city on importation of water from far away.

\*2 As the project developed, Mr. Leicester's proposals were subjected to a number of approval pro-

cesses. His artistic renditions needed to satisfy the building owners, who apparently were concerned that they have a project which was not too "far out" to discourage tenancy. Cost considerations also existed. Additional problems existed with the CRA requirements. Particularly with relevance to this case, CRA required that there be a "streetwall" extending southerly from the building to the property edge. The authorship of four of the five towers consisting of the streetwall, which appeared in the allegedly infringing movie "Batman Forever" will be described in more detail in the section below on authorship.

In 1994, Warner Bros., desiring to produce a moving picture entitled "Batman Forever", approached R & T for permission to photograph the R & T property for use in the movie. R & T, without consulting plaintiff or the architect, signed a contract granting Warner Bros. broad permission to make replicas or pictorial representations of the R & T property in connection with the making of the Batman Forever movie. Portions of the artistic development appear in the movie. Briefly appearing in the movie (and the subsequent videotape taken from the movie) are the two lantern towers and the two smoke towers, as well as the building itself. In the movie, the building represents the "Second National Bank of Gotham City", the locale of numerous nefarious deeds at the beginning of the movie. The balance of ZM, including the vampire column, and the portions of Zanja Madre in the courtyard, do not appear in the movie. In addition, Warner Bros. made a three-dimensional model of the building and of the zanja Madre, which may have been used partly in the movie. In addition, Warner Bros. published a number of promotional items in connection with the Batman movie, including a comic book, posters, and tee shirts. Some of these items also showed the two lantern columns and the two smoke columns, together with portions of the building, but nothing else of ZM.

Mr. Leicester registered his **copyright** in 1995 and brought this suit against Warner Bros. and its affili-

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ated companies for copyright infringement.

b. *Contract Issues*: Mr. Leicester claims to be the owner of the **copyright** in the whole of ZM. He registered his claim with the **Copyright** Office, where it was allowed as a sculptural claim (not as an architectural work). Mr. Leicester had entered into a contract with R & T in 1990, which purported to define the respective rights of the artist (Leicester) and R & T. This contract was executed August 21, 1991. The contract purports to divide the work into two parts. Phase A involved the collaborative design efforts of the artist with the architect. Phase B involved "the artist's design, fabrication, and procurement of objects and materials which shall be installed by [the general contractor]." Paragraph 3 of the contract purports to describe the respective copyright rights of the parties. The pertinent portions of that paragraph read:

\*3 "The Artist retains all rights under the Copyright Act of 1976...and all other rights in and to the Phase B portion of the Work...except as such rights are otherwise limited by this Section of the Agreement. In view of the intention that the Work in its final dimension shall be unique, the Artist shall not make any duplicate, three-dimensional reproductions of the final Work, nor shall the Artist grant permission to others to do so. The Artist grants to the Owner, and to the Owner's related corporate entities, and to the Owner's assigns a perpetual irrevocable license to make reproductions of the work including but not limited to reproductions used in advertising, brochures, media publicity, and catalogs or other similar publications...."

The last subparagraph of paragraph 3 reads as follows:

"The Artist further represents and warrants that he will not, under any circumstances, duplicate any portion of the Work for use on any other Project or for use of any other client of the Artist."

A subparagraph of paragraph 10 reads as follows:

"The Owner agrees that all two-dimensional or

three-dimensional reproductions of the Phase B portion of the Work, made by the Owner, shall contain a copyright notice in substantially the following form: 'Andrew Leicester, 1992.'"

During summary judgment motions, the court determined that certain of the provisions quoted above had ambiguities, and that the matter needed to be tried. That trial has now concluded and the interpretation of the contract is determined as set forth below:

(1) Three-dimensional copy: The contract, quoted above, clearly provides that Leicester grants a license to R & T to make three-dimensional reproductions. Copyright law is such that the grant of the license may not be assigned or sublicensed by the licensee unless the grant of the license is exclusive. (*Harris v. Emus Records Corp.* 9Cir'84 734 F.2d 1329, 1333; *Nimmer, Nimmer on Copyrights*, § 10.01[c][4] (1983); *cf. In re CFLC* 9Cir'96 89 F3d 673, 679-80.) The first question, therefore, is whether Leicester's grant of the license to R & T to make three-dimensional reproductions is exclusive. The contract does not expressly say so. However, in connection with the grant of the license to R & T to make the three-dimensional reproductions, Leicester also agrees that he himself will not make such reproductions or allow anyone else to do so. With the combination of the grant of the license to R & T, plus the provision disabling Leicester from making three-dimensional reproductions or licensing others to do so, the court concludes that R & T's license is exclusive. Therefore, R & T may sublicense others to make three-dimensional reproductions. The contract between R & T and Warner Bros. has a grant of a sublicense in broad enough terms to cover three-dimensional reproductions. The court concludes that with the exclusive license to R & T, it had the right to sublicense three-dimensional reproductions to Warner Bros., and did so.

\*4 In this connection, plaintiff argues that the term "three-dimensional reproductions" should be limited to reproductions on the same scale as the ori-

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ginal. The Warner Bros. model was on a small scale. Plaintiff's construction in this respect is rejected. The term three-dimensional reproductions is not further defined in the contract and there is no reason to give it the narrow meaning plaintiff suggests. The court concludes that insofar as Warner Bros. made a three-dimensional model of the building and ZM, it did so pursuant to a valid grant of sublicense from R & T.

(2) Two-dimensional reproductions: The bulk of the copies made by Warner Bros. in this case were pictorial reproductions, in photography or artistry, which included portions of ZM. In the Leicester-R & T contract, R & T is expressly given the right to make two-dimensional reproductions (i.e., pictorial reproductions). Leicester also retains the right to make two-dimensional reproductions. Accordingly, the R & T license is not exclusive. Under copyright law, R & T does not have the right to sublicense another under such a non-exclusive license.

Defendant argues that the import of the language quoted above, allowing R & T the right to make reproductions of the work and to "assign" that to the owner's "related corporate entities" and to the "owner's assigns", includes a grant of a right to sublicense others. The court declined to determine this matter on summary judgment, finding the language ambiguous. It is now determined that the language does not give R & T the right to sublicense others to make two-dimensional reproductions except in connection of a transfer of the contract to a "related corporate entity" and to the "owner's assigns" meaning the assigns of the contract in question. The contract in question was not assigned, and therefore it is construed not to allow sublicensings to others who are not recipients of an assignment of the Leicester-R & T contract. The court therefore rejects defendant's position that R & T has the right in the contract to sublicense Warner Bros. to make photographic or other pictorial copying of ZM.

c. *Who are the "Authors" of ZM?* Zanja Madre, as the exhibits show, consists of numerous separate works assembled in conjunction with one another to

tell an allegorical story. The bulk of these works were the sole creation of the plaintiff, Mr. Leicester. This includes the contents of the courtyard, including the split mountain, the arrowhead, the fountain, the water channel leading to the parts of the city, and the representation of the city with the two tall "building towers" and the two "drill towers." However, none of these elements appeared in the Batman movie, video, or promotional works for Batman Forever. What does appear in the Batman movie and video, and partially appears in the promotional materials, are the two "lantern towers" and the two "smoke towers." These items consist of most of the "streetwall" which extends southward along the building line from the building to approximately the end of the property line. The evidence is that the architect, Mr. Hayes, and his company, TAC, were joint authors with Mr. Leicester of the four towers. The court concludes this from a number of factors. First, CRA from the beginning required, and Mr. Hayes designed, a "streetwall" along the Figueroa Street frontage of the property designed to carry visually the line of the building toward the southerly property line. As the design ultimately matured, the materials which made up the towers were duplicated from the materials designed by Mr. Hayes into the building. The pilasters (uprights) for the first three floors of the building consisted of pink granite and green marble, mounted on a granite box faced with black marble. The material which consists of the bulk of the two light towers and the two smoke towers are constructed from identical material. The evidence shows that Mr. Leicester conferred and contributed ideas to Mr. Hayes' design of the first three floors of the building and that Mr. Hayes conferred and contributed ideas to Leicester's ultimate acceptance of the building format in constructing the four towers. In addition, at the third floor level, the building has a series of lanterns (exhibits 193 and 195). The scheme of these lights was carried into the lanterns on the lantern towers, which were made of identical material and designed to be at the same level and complement the lights at the third floor level of the building. In addition, the location of the

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towers was first fixed by Mr. Hayes to match up to the same distance as the distance between the pilasters of the building and to be in the same line as those pilasters (seen from two angles in exhibits 193 and 197). The court concludes that Mr. Hayes and his architectural firm were joint authors with Mr. Leicester of the two light towers and the two smoke towers. The shorter vampire tower differs but cannot be seen in the movie or the video. In addition, from the beginning of the project, even before the hiring of Mr. Leicester, Mr. Hayes and his architectural firm contributed to the design and placement of the towers. The court concludes he is a joint author of the four relevant towers.

\*5 The next question has to do with the legal effect of this finding. The first question to consider is whether the towers as a whole, including the decorative elements at the top (the lanterns, the grill on the lantern towers, and the smoke design on the smoke towers, which were created by Mr. Leicester) should be considered a part as the tower as a whole. The court concludes that it should be. Each tower appears to be an integrated concept which includes both architectural (see below) and artistic portions. Mr. Hayes, the architect, contributed the primary creative work as to certain portions of the towers, Mr. Leicester and Mr. Hayes jointly created much of the artistic appearance of the base of the towers up to the decorative point, and Mr. Leicester created the artistic decorations at the top of the towers. Looked at as a whole, the towers should be considered as one unit. In that respect, the court concludes, therefore, that Mr. Leicester and Mr. Hayes (or his architectural firm) are joint authors of the towers.

Plaintiff assumes that the decorative portion of the towers should be looked at alone as "conceptually separate" artistic embellishments of the whole. The court rejects this viewpoint since the artistic and architectural impression is one created by the towers as a whole, complementing the pilasters and not by a separate sculptural element alone and further, because the lanterns are designed to continue the

theme of the third floor lanterns of the building.

Assuming, therefore, that the portion of ZM relevant to this action-the four towers pictured by Warner Bros.-has joint authors, it appears that one owner of a joint authorship work may sue for infringement of the joint work. Cf. *Nimmer, Nimmer on Copyright*, § 6.10 (1997); *Oddo v. Ries* 9Cir'84 743 F.2d 630, 633. Accordingly, Leicester, without being joined by Mr. Hayes, may sue for the alleged infringement by Warner Bros. The fact that Mr. Hayes, or his firm, is the joint owner of the copyright in the four towers, would not prevent this suit.

The next question is raised by the purported "grant" of the license by Mr. Hayes to R & T in May, 1996. After this lawsuit had been pending for approximately 1-1/2 years, Mr. Hayes signed a document which purported to grant a license to R & T to permit reproductions and purported to allow R & T to sublicense that right. Defendant now contends that this retroactive grant of the license validates the R & T grant of the sublicense to Warner Bros. and therefore obviates the maintenance of this suit by Mr. Leicester. The court rejects this argument. First, the co-owner of a copyright may, without the consent of the other owner, grant only a non-exclusive license. Accordingly, any license granted by Mr. Hayes to R & T was non-exclusive and therefore does not allow R & T to grant a sublicense under it. R & T, which already had a non-exclusive license for photos under its contract with Mr. Leicester, did not acquire anything additional by a non-exclusive license conveyed to it by Mr. Hayes. The portion of the assignment which in addition purports to allow R & T to sublicense others (here read Warner Bros.) is invalid for the same reason that R & T could not sublicense under its non exclusive license from Mr. Leicester.

\*6 The court rejects the defense argument for another reason. At the time Warner Bros. took the pictures and made pictorial reproductions of ZM, it had no license to do so. Its actions at that time, if an infringement of Mr. Leicester's copyright, could not be later validated by the grant of the license.

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Even assuming Mr. Hayes could grant a license directly to Warner Bros. (which he has not purported to do), he has still not done so. The court rejects the idea that the earlier infringement can be retroactively validated by the later grant of the license.

The result is that the findings made by the court set forth above (that Mr. Hayes or TAC is the co-author of the four relevant towers constituting the streetwall) has no legal effect in this suit. Mr. Leicester, as co-author, and therefore co-owner of the copyright, may maintain suit for the alleged infringement.

d. *Are the Four Relevant Towers an Architectural Work?* Defendant contends that the four towers shown in the Warner Bros. movie, video, and promotional materials, are an "architectural work" within the meaning of Section 102(a)(8) and therefore, may be photographed or otherwise reproduced pictorially pursuant to Section 120(a). In 1990, Congress amended Section 102 of the Copyright Act, which lists the types of items subject to copyright protection. In that amendment, Congress added "architectural works" to the protected works under the Copyright Act. With the amendment, Congress also adopted Section 120(a) which reads as follows:

"The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place."

The defendant claims the protection of Section 120(a) in this suit. The court concludes that the preponderance of the evidence is that the four relevant towers are a portion of the architectural work which includes the building and those four towers. Architectural work is defined in Section 101 as "an architectural work is a design of a building as embodied in any tangible medium of expression, including a building, architectural plans or drawings. The work

includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features." The definition does not materially assist in solving the question in this case.

The history of the architectural work coverage is that United States adhered to the Berne Convention, adopted by the United States in the late 1980's. The Berne Convention required copyright protection for, among other things, architectural works. Congress took up the study of whether the then existing copyright law sufficiently protected architectural works to qualify under the Berne Convention, and asked for and received a report from the Registrar of Copyrights. That report concluded that the United States was not in compliance with the Berne Convention, since copyright protection for architectural works was only extended at that time to the plans and drawings created by the architect, but not to the architectural work as constructed. Accordingly, Congress adopted Sections 102(a)(8) and 120(a). That congressional history gives some guidance but does not provide definitive answers for the problem in this case, which is to define the scope of the new "architectural work" coverage. Further, there are no reported cases which throw light on the subject.

\*7 It is apparent, subject to the possible application of the "conceptual severability" doctrine, that the pictorial representations made by Warner Bros. are protected from an infringement suit by Section 120(a) if the four towers depicted are a part of the "architectural work" of the building. Much evidence was received pro and con on this point.

The court has concluded that the preponderance of the evidence is that the four towers are a part of the architectural work and that therefore, Section 120(a) applies, allowing the pictorial representations made by the defendant.

The conclusion is reached because the preponderance of the evidence is that the four towers have functional aspects designed to be a part of the

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building plan. The towers constitute a "streetwall", most clearly illustrated in exhibit 193, which is a photograph taken looking southerly along Figueroa Street from the main building entrance at the corner of 8th and Figueroa. First, the towers are placed exactly to match the distance apart of the risers or pilasters of the building. Secondly, the towers up to their decorative parts consist of the same material as the pilasters of the building and are clearly designed to give the impression that the building continues along to the end of the property line, as apparently required by CRA. The bases of the towers are identical with those of the pilasters, the pink granite is the same, and the green marble is the same. In addition, from their appearance, the four towers are otherwise also designed to match up with the architecture of the building. Exhibit 197 shows that the lanterns on the lantern towers are designed to match up to the lanterns at the third floor level attached to the building proper (see exhibits 193 and 197). In addition, the four columns also serve another functional purpose. They serve to channel the traffic into the courtyard through gates which are affixed to the towers and can be closed when the courtyard is to be closed (presumably at night). Thus, the columns serve the functional purpose not only of directing the traffic into the courtyard but of controlling that traffic. The "streetwall" purpose is also emphasized by the use of three more "smoke towers" on the opposite corner of the building on 8th Street, again placed at the building line the same distance apart as the pilasters of the building (exhibit 195). In addition, it must be said that the requirement of the CRA that there be a street wall continuing along the building line to the end of the property is an architectural purpose, not an artistic purpose, and was imposed as an architectural requirement from the beginning. The artist and architect carried out this architectural requirement of CRA. The towers contain artistic work, particularly at the tops thereof, which are purely artistic work incorporated into the tower structure and design. The court concludes that the preponderance of the evidence is that the towers are a part of the architectural design of the building. Section 120(a)

therefore allows the pictorial representations done by Warner Bros. unless the towers, or portions thereof, can be said to be protected by the doctrine of "conceptual separability."

\*8 The most difficult legal part of this determination is the question of whether the doctrine of conceptual separability for sculptural items incorporated in an architectural work has **copyright** protection as sculptural work which survived the 1990 amendment. Plaintiff's position is that the 1990 amendments intended only to add architectural works to **copyright** protection, but did not intend to repeal previously authorized protection to sculptural works which were, theretofore, protected under the sculptural work coverage of the **Copyright** Act if "conceptually separable" from the building of which it was a part. Prior to the 1990 amendments, buildings as such had no **copyright** protection. However, portions of buildings which had original artistic work not a part of a functional, utilitarian, or useful role in the architecture, could be protected under sculptural coverage in the **Copyright** Act. The existence of this coverage is recognized in the House Committee's report. However, whether the 1990 amendments, and particularly Section 120(a), removed this "conceptually separable" protection for sculptural works forming a part of an architectural work has divided the commentators on the new architectural work exception. In addition, there are no cases which elucidate.

The court concludes that the intent of Congress was to substitute the new protection afforded architectural works for the previous protection sometimes provided under the conceptual separability test for non-utilitarian sculptures (such as gargoyles and stained glass windows) incorporated into a work of architecture. If this construction is correct, the enactment of Section 120(a) had the effect of limiting the conceptual separability concept to situations not involving architectural works.

The congressional report does not fully provide an answer to the problem. In footnote 41, the committee says:

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"The subcommittee was aware that certain works of authorship which may separately qualify for protection as pictorial, graphic, or sculptural works, may be permanently embedded in architectural works. Stained glass windows are one such example. Election is inappropriate in any case where the **copyright** owner of a pictorial, graphic or sculptural work embodied in an architectural work is different from the **copyright** owner of the architectural work."

The last sentence of that paragraph is somewhat obscure, but the court reads it as saying that the author of a pictorial, graphic, or sculptural work who is not the same person as the holder of the copyright in the architectural work does not have separate protection for that work. Accordingly, the court reads footnote 41 as tending to support an intention that section 120(a) modifies previous rules for sculptural work protection embedded in architectural works.

Another clue may be found in footnote 43 of the congressional report. That footnote stated in part:

"Monumental, non-functional works of architecture, are currently protected... as sculptural works. These works are, nevertheless, architectural works, and as such, will no[w] be protected exclusively under Section 102(a)(8) [the architectural work's coverage]."

\*9 The difficulty with this quotation is that in the original, the word "now" was printed as "not." The policy advisor to the Registrar of Copyrights, one of the authors of the study preceding the adoption of the Act, states that the word "not" was a typographical error and was intended to read "now." If that is correct, then footnote 43 supports the proposition that what was previously protected as sculptural work (in the shape of monumental works) are now to be protected as architectural works.

Certain of the writers in copyright disagree. Nimmer, for example, discussing monumental works

(not gargoyles, etc.) states that a monumental work could be eligible for dual protection both as a "sculptural work" and as an "architectural work." On the other hand, Patry, the former policy advisor to the Registrar of Copyrights, expresses the position that as to architectural works, only the architectural works provision now covers portions of them.

Looking at the policy of the architectural works exception, which is to give protection to such works, but nevertheless to allow free use of photography or other pictorial representations, it seems that the most likely intent of Congress is to give the architectural works protection to all parts of an "architectural work", with the proviso that Section 120(a) (allowing pictorial copying) applies. If this interpretation is correct, the former doctrine of "conceptual separability" as it applied to a pictorial, graphic or sculptural work embedded as part of a building, has been modified by the 1990 amendments. The court adopts this interpretation of the Act.

Having concluded that the four towers depicted by Warner Bros. in their film, videotape, comic book, and promotional materials were only of the four towers which were part of the "architectural work", having concluded that pictorial representations are allowed under Section 120(a), judgment should be entered for defendant. Defendant to provide form of judgment.

C.D.Cal., 1998.

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Not Reported in F.Supp., 1998 WL 34016724 (C.D.Cal.), 47 U.S.P.Q.2d 1501

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